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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,856	05/30/2001	Koji Hattori	P/1071-1358	9007
32172	7590	08/09/2005	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LOPEZ, CARLOS N	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/867,856

Applicant(s)

HATTORI ET AL.

Examiner

Carlos Lopez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-13 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-13,21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/30/04</u> . | 6) <input type="checkbox"/> Other: _____  |

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1) Claims 1, 3 and 21 are rejected under 35 U.S.C. 103(a) as obvious over Kodas et al (US 6,360,562). Kodas discloses using a spray-thermal decomposition method for producing hollow and non-hollow glass powders (Col. 31, lines 10ff). Kodas provides a liquid feed line 102 to aerosol generator 106 wherein the liquid is turned into aerosol 108. The aerosol is then fed to a furnace 110 where glass particles 112 are produced (Col. 5, lines 19-27). The liquid feed line 102 includes multiple precursors materials which may be present in a single phase or alternatively one precursor could be in a solid state (colloidal silica) and a second precursor in a liquid phase (a metal salt) (Col. 6, lines 1-13). As shown in col. 26, lines 35ff, the liquid feed line 102 comprises metal precursors (deemed as the claimed water-soluble compound) such as nitrates, acetates and chlorides of a metal, which are highly soluble. In Col. 30, lines 31ff, the liquid solution comprises a raw material oxide powder ( $\text{SiO}_2$ ) and a precursor for the intermediate oxides ( $\text{Al}_2\text{O}_3$ ). Thus the liquid feed line comprises a mixed solution having the claimed raw material oxide powder ( $\text{SiO}_2$ ), water-soluble compound (nitrates, acetates and chlorides), and a different glass forming element ( $\text{Al}_2\text{O}_3$ ) all mixed into a solution and thus resulting in applicant instant claim 1 mixed solution.

The resulting glass particles 112 range in size from  $0.05\mu\text{m}$  up to about  $20\mu\text{m}$  (Col. 30, lines 37-52). Raw material oxide powder range has varying sizes from  $1\mu\text{m}$ , smaller than  $0.5\mu\text{m}$ , smaller than about  $0.3\mu\text{m}$ , or smaller than about  $0.1\mu\text{m}$  (Col. 5, lines 40-43). Thus showing that Kodas raw material powder is either not more than  $1/5$  of the average particle size of the resultant glass powder as instantly claimed or is more than about  $1/25$  of the average particle size of the resultant glass powder as instantly claimed. The aluminosilicate glass composition of Kodas has a melting point in the range of 700 to 950 degrees Celsius as evidenced by Yoshikawa et al (Machine Translation). Kodas spray thermal decomposition temperature is in the range of 300 to 1500 degrees Celsius (Col. 27, lines 49) thus showing that Kodas thermal decomposition temperatures meets Applicant's claimed treatment temperature.

As shown in Tables I and II, the formed glass has a raw material oxide powder ( $\text{SiO}_2$ ) concentration of 8 –26% by weight or 54-55% by weight falling in both of applicant's claimed raw material oxide powder concentration. Since the glass powder is formed from drops of the Kodas mixed solution, it would thus be obvious to a person of ordinary skill in the art that the concentration of Kodas solution has a concentration of less than and or optionally greater than 45% by weight as claimed by applicant.

It is also noted that Kodas does not explicit disclose that the liquid is aqueous it is understood in the art that if a solution includes water soluble compounds in its dissolved form, the solvent used, absent any indication, would be water. Applicant is also referred to Rosencwaig, which notes in the abstract that the liquid, which is sprayed thermally to obtain glass powder is an aqueous solution.

In regards to the claimed step of heating the mixed solution with a radiant heat, applicant is referred to Col. 8, lines 48ff, showing the furnace 110 can be a metallic tube, which would emit radiant heat.

As for claim 21, the claimed steps of identifying the melting point of the resultant glass powder, the amounts of raw material oxide and water soluble compound converted to an oxide, are necessary and obvious steps made in order to provide the proper decomposition temperature that would melt the raw material and converted water soluble material.

2) Claims 4-13 are rejected under 35 U.S.C. 103(a) as obvious over Kodas et al (US 6,360,562). As noted above Kodas discloses a spray thermal decomposition method for making glass powder. Claims 4 further recite the concentration of the raw material oxide powder and solutes in the mixed solution. It is noted that Kodas teaches that the concentration of the solutes is a result effective variable affecting the size of the resultant produced glass powder (Col. 27, lines 6-9). Thus it would have been obvious to a person of ordinary skill in the art at the time the invention was made to have conducted routine experiments to determine the effective concentration that would yield the desired glass powder particle size.

Claims 6-13 recited various combinations either further limiting the particles size or changing the concentration of the raw material oxide powder in relation to the water-soluble compound. As noted above the concentration of the raw material oxide powders depend on the desired glass powder size. In the same manner Kodas teaches that the raw material oxide powder's size depends on the particular application of the

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glass powder (Col. 30, lines 39-41). Thus showing that the raw material oxide powder is a result effective variable, which through routine experimentation its concentration is selected based on the application of the glass powder being sought.

**3)** Claims 1,3-13 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodas et al (US 6,360,562) in view of Rosencwaig et al (US 4257799).

If applicant considers that Kodas' glass composition is different from the glass composition of Yoshikawa et al which was used to show that Kodas treats the glass raw material oxide above the melting point of the glass powder melting point, a rejection of the claims based on said interpretation follows.

As noted above Kodas discloses a spray thermal decomposition method for making glass powder. Kodas is silent treating the glass raw material oxide above the melting point of the glass powder melting point. Rosencwaig discloses a vertical drop oven for making glass powders using the thermal decomposition method (Abstract and Col 4 lines 3-22). Rosencwaig et al teaches that thermal decomposition of a solution in a multi stage oven wherein the temperature of a stage is higher than the preceding stage results in high quality micro sphere glass powders (Col. 2, lines 55ff). The stage having the higher temperature treats the glass powder precursor solution at temperature above 200 degrees Celsius of the melting point of the glass composition precursor solution. Thus at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to have thermally decomposed Kodas solution with Rosencwaig multistage oven (wherein the solution is treated at a temperature above

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200 degrees Celsius of the melting point of the glass composition) to thus produce high quality micro sphere glass powders.

It is noted that Kodas does not explicit disclose that the liquid is aqueous it is understood in the art that if a solution includes water soluble compounds in its dissolved form, the solvent used, absent any indication, would be water. Applicant is also referred to Rosencwaig, which notes in the abstract that the liquid which is sprayed-thermally to obtain glass powder is an aqueous solution.

As for claim 4, Kodas teaches that the concentration of the solutes is a result effective variable affecting the size of the resultant produced glass powder (Col. 27, lines6-9). Thus it would have been obvious to a person of ordinary skill in the art to conduct routine experiments to determine the effective concentration that would yield the desired glass powder particle size.

Claims 6-13 recited various combinations either further limiting the particles size or changing the concentration of the raw material oxide powder. As noted above the concentration of the raw material oxide powders depend on the desired glass powder size. This shows that the raw material oxide powder is a result effective variable, which through routine experimentation is selected based on the sought application of the glass powder.

In regards to the claimed step of heating the mixed solution with a radiant heat, applicant is referred to Col. 8, lines 48ff, showing the furnace 110 can be a metallic tube, which would emit radiant heat..

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As for claim 21, the claimed steps of identifying the melting point of the resultant glass powder, the amounts of raw material oxide and water soluble compound converted to an oxide, are necessary and obvious steps made in order to provide the proper decomposition temperature that would melt the raw material and converted water soluble material.

### ***Response to Arguments***

Applicant's arguments filed 5/16/05 have been fully considered but they are not persuasive.

Applicant also argues that the ratio of particle size range of the raw material oxide to the size of the glass powder is an extremely large number and that there is nothing in Kudas that would suggest a raw material oxide powder not more than 1/5 of the average particle size of the glass powder. Said argument does not negate the fact that Kudas disclose and envisages the claimed ratio. Nor has applicant provided any unexpected results concerning the 1/5 ratio.

In response to applicant's argument that the reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., employing radiant heat to produce solid spherical glass particles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant claims do not specify the glass powder is a solid spherical glass particle.



It is noted that the instant claims do not recite that the pyrolysis temperature is a function of raw material amount and amount of water soluble compound. The claims only recite different scenarios wherein the pyrolysis temperature is changed based raw material amount and amount of water soluble compound for which Kodas reads on to at least one of those scenarios. The claims do not recite a step of determining the pyrolysis temperature based on raw material and amount of water soluble compound as argued. Again it is emphasized that the instant claims only recited different scenarios wherein the pyrolysis/decomposition temperature is varied based on the selected raw material amount and amount of water soluble compound. Hence there is no "determining step" limitation as argued.

In regards to the argument that Kodas does not show the significance of 45% and 1/25, it is noted that it is not required to show the significance of 45% and 1/25. If there is a requirement for showing the significance of 45% or 1/25, it is asked what is the required significance to be shown? Kodas provides different raw particle sizes being treated above the claimed thermal decomposition temperature and thus meeting the claimed scenarios.

Applicant also argues that Kodas teaches away from claims 8,9,12 and 15 because the feed line only discloses a 15% raw material oxide powder. It is noted that Kodas specifically discloses that the concentration of the solutes in the solution would depend on the desired size of the glass powder. Hence showing that if a bigger glass powder is desired, a higher concentration of solutes, such as those recited in claims 8,

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9,12 and 15, would be required. Thus while Kodas give examples using 15% it does not constitute a teaching away.

Applicant's arguments against Rosencwaig fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant also presents a declaration from the inventors attesting that the glass particles are solid and spherical and unexpected because of the use of radiation heat. However, the declaration is not commensurate with the claimed invention. The claimed invention does not specify that the glass particles are solid and spherical. In fact applicant is directed to its invention in the first paragraph of page 7 showing concentration of the raw material has a direct effect on whether the formed particle is hollow or solid; Hence, showing that radiant heat is irrelevant on the type of particle sought to be made.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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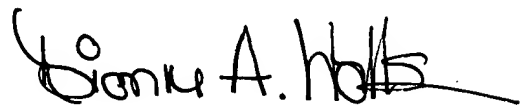
extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carlos Lopez whose telephone number is 571.272.1193. The examiner can normally be reached on Mon.-Fri. 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571.272.1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CL

  
**DIONNE A. WALLS**  
**PRIMARY EXAMINER**